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No. 01-1

Supreme Court, U.S
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IN THE

Supreme Court of the United States

BRIDGESTONE/FIRESTONE, INC.,

Petitioner,

v.

POLYMER INDUSTRIAL PRODUCTS COMPANY
and POLYMER ENTERPRISES CORPORATION,

Respondents.

Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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REPLY TO BRIEF IN OPPOSITION

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September 6, 2001

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REASON FOR REPLY

Pursuant to Supreme Court Rule 15. 6., this Petitioner files a Reply Brief addressed to new points raised by the Brief in Opposition.

The Brief in Opposition challenges the right of this Petitioner to seek a Writ of Certiorari with this Court, asserting that this Petitioner did not preserve the issues at the courts below. That challenge misidentifies this Petitioner's conduct at the lower courts.

This Petitioner briefed the issues of claim construction to the trial court in Petitioner's Motion for Judgment as a Matter of Law ("JMOL") following the jury verdict. This Petitioner did object at trial to the Willfulness instruction given to the jury. This Petitioner did object at trial to the Lost Profits Damages instruction given to the jury.

Claim construction is matter of law, reviewed *de novo* by the United States Court of Appeals for the Federal Circuit ("Federal Circuit").

The legal correctness of the various factors to be included in the Willfulness instruction was challenged at trial and briefed on appeal.

The legal correctness of a Lost Profits Damages instruction was reviewable, *de novo*, by the Federal Circuit. But the Federal Circuit did not address the legal erroneousness of the trial court's jury instruction, only the burdens of proof the respective litigants have as to the evidence considered under that jury instruction.

PARTIES TO THE PROCEEDING

Petitioner, Bridgestone/Firestone, Inc., has a parent company, Bridgestone Corporation of Tokyo, Japan.

Bridgestone/Firestone, Inc. does not issue shares to the public and is wholly owned by Bridgestone Corporation. Bridgestone Corporation issues shares to the public. There are no other subsidiaries or affiliates of either Bridgestone/Firestone, Inc. or Bridgestone Corporation that have issued shares to the public.

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REPLY

I. *Certiorari* Should Be Granted Because Claim Construction is Reviewed *de novo* by the Federal Circuit and this Petitioner Preserved Its Appeal to that Court.

Claim construction is reviewed, as a matter of law, *de novo*, by the Federal Circuit. *Markman v. Westview Instruments, Inc.* 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996).

This Petitioner preserved its objections on claim construction[1] and briefed the issue before the Federal Circuit. Unfortunately, that Court's treatment of the law of claim construction in this litigation encountered the "sometime" and unpredictable fine line between

"reading a claim in light of the specification"

as opposed to

"reading a limitation into the claim from the specification"[2]

Specifically, over this Petitioner's objection, the trial court refused to instruct the jury that a bladder similar to Figure 4 cannot infringe the product claims of the '331 patent. (A3314; A2664; A2517 of the Federal Circuit Appendix) This erroneous jury instruction, based on a misconstruction of the claims, was briefed in this Petitioner's JMOL motion before the trial court and in the appeal to the Federal Circuit.

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[1] The Federal Circuit was not bound by the jury instructions, even in the absence of an objection, when reviewing a renewed motion for JMOL. *Markman v. Westview Instruments, Inc.* 52 F.3d 967, 975 n.5 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). This was a topic at Oral Argument; the Federal Circuit did continue with its claim construction efforts, albeit erroneously.

[2] *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998)

Therefore, this Petitioner's claim construction issue is properly preserved for this Petition for Certiorari. If given the opportunity with a grant of the Writ of Certiorari, this Petitioner will demonstrate why the Federal Circuit's conflicted law of claim construction did not permit a proper consideration of Figure 4 in the '331 patent and the necessary interpretation of the product claims of that '331 patent which require:

> ... a fabric layer of spaced cords *calendered with a coating of unvulcanized uncured rubbery polymer partially embedded in the rubbery polymer surface,* the spaces between the cords being free of said polymer at said surface *so that such cords project above said surface.* (Emphasis Added)

Everyone recognized that "unvulcanized uncured rubbery polymer" is not in the final claimed product. How one gets from "unvulcanized uncured rubbery polymer" to a cured product where cords "project above the surface" requires interpretation of the claim language. That the only known way to get from "uncured rubbery polymer" to the projecting cord product is "abrading" is a subset of the main issue of claim construction: what do these claims mean, when the disclosure of Figure 3 is covered by the claims but the disclosure of Figure 4 is not?

Within the context of imperfect claim language all too often present in issued patents, this Petition presents this Court with an opportunity to reconcile the unpredictable difference between reading claims in light of the specification vs. reading a limitation into the claim from the specification.[3]

According to Judge Dyk of the Federal Circuit, the Federal Circuit does not provide adequate guidance as to

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[3] *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998)

when it is appropriate to look to the specification to narrow the claim by interpretation and when it is not appropriate to do so. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1347 (Fed. Cir. 2001) (concurring opinion).

II. *Certiorari* Should Be Granted Because Objections to Erroneous Jury Instructions were Preserved for Appeal but not Addressed by the Federal Circuit, the Only Available Forum.

There are two more jury instructions that this Petitioner objected to at the trial and briefed before the Federal Circuit, neither of which received appropriate attention from the Federal Circuit panel:

the Willfulness Instruction (A2520; A3402-A3404 of the Federal Circuit Appendix), and

the Lost Profits Damages instruction (A2519 of the Federal Circuit Appendix).

With respect to the Willfulness instruction, this Petitioner briefed the Federal Circuit that it challenged the jury instruction because it contained factors that demonstrate willfulness (which is for the jury) with the factors that can support enhancement (which is committed to district-court discretion). From this Petitioner's reading of the Federal Circuit opinion at App. 9a, this argument of confusion of factors was not addressed and should have been. The Federal Circuit only addressed what happened after the jury returned its verdict, not the instruction that was given to create that verdict. The Federal Circuit did not address the erroneousness of the jury charge itself.

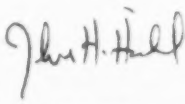
With respect to the Lost Profits Damages instruction, the jury was not instructed about the required second step of the lost-profits analysis. Regardless of who had the burden to prove it, the jury was not required to even consider the presence of non-infringing alternatives. That instruction is

contrary to law, which is reviewable *de novo*, by the Federal Circuit.[4] If given the opportunity with a grant of the Writ of Certiorari, this Petitioner will demonstrate why the Federal Circuit's failure to address this appealed issue harmed this Petitioner, because it is undeniable that even with a two-supplier market, this Petitioner made and sold to its own tire plants many bladders that were non-infringing alternatives.[5]

CONCLUSION

For the reasons set forth in the Petition for Writ of Certiorari dated June 28, 2001 and in this reply above, the petition should be granted.

Respectfully submitted,



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[4] *Markman v. Westview Instruments, Inc.* 52 F.3d 967, 975 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996).

[5] Intracompany sales of supposedly-infringing bladders were included for calculation of damages; Intracompany sales of non-infringing alternatives were not considered for determination of lost profit damages. At trial, this Petitioner was penalized by including the first but not considering the second.